

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

RONALD A. KATZ TECHNOLOGY
LICENSING, L.P.,

Plaintiff,

V.

TD BANKNORTH INC., et al.,

Defendants.

C.A. No. 06-544 (GMS)

**DEFENDANT TD BANKNORTH, INC.'S MOTION
TO STAY ACTION PENDING THE UNITED STATES PATENT AND
TRADEMARK OFFICE'S REEXAMINATION OF PLAINTIFF'S PATENTS**

Defendant TD BankNorth, Inc. (“Defendant” or “TD BankNorth”) hereby moves the Court to stay this action in its entirety pending the reexamination proceedings by the United States Patent and Trademark Office relating to patents asserted in this action by Plaintiff Ronald A. Katz Technology Licensing, L.P. (“RAKTL” or “Plaintiff”). By this motion, Defendant incorporates herein by reference the Motion to Stay filed by the Qwest Defendants in Civil Action No. 06-546 (GMS) on Monday, December 18, 2006, and the memorandum and declaration filed in support thereof. (C.A. No. 06-546, D.I. 80-82) and the motion filed earlier today by the Dillard’s Defendants in this case. (D.I. 64).

On September 1, 2006, Plaintiff filed five actions in this District¹ accusing a total of ninety-five defendants of infringing one or more of twenty-six United States patents.² Plaintiff has asserted nineteen of the twenty-six patents against TD BankNorth in this action.³

Currently, eleven RAKTL patents are involved in reexamination proceedings before the United States Patent and Trademark Office.⁴ Of these eleven patents, six patents that are asserted against TD BankNorth are involved in reexamination proceedings before the United States Patent and Trademark Office and a request for reexamination has been submitted for an

¹ *Ronald A. Katz Technology Licensing, L.P. v. Reliant Energy, Inc., et al.* (Civil Action No. 1:06-cv-00543), *Ronald A. Katz Technology Licensing, L.P. v. TD Banknorth, Inc., et al.* (Civil Action No. 1:06-cv-00544), *Ronald A. Katz Technology Licensing, L.P. v. Ahold USA, Inc., et al.* (Civil Action No. 1:06-cv-0545), *Ronald A. Katz Technology Licensing, L.P. v. Time Warner Cable, Inc., et al.* (Civil Action No. 1:06-cv-0546), and *Ronald A. Katz Technology Licensing, L.P. v. American International Group, Inc., et al.* (Civil Action No. 1:06cv-00547).

² The twenty-six asserted patents are United States Patent No. 4,792,968 (“the ‘968 patent”); 4,930,150 (“the ‘150 patent”); 4,939,773 (“the ‘773 patent”); 4,987,590 (“the ‘590 patent”); 5,128,984 (“the ‘984 patent”); 5,251,252 (“the ‘252 patent”); 5,297,197 (“the ‘197 patent”); 5,351,285 (“the ‘285 patent”); 5,442,688 (“the ‘688 patent”); 5,684,863 (“the ‘863 patent”); 5,787,156 (“the ‘156 patent”); 5,815,551 (“the ‘551 patent”); 5,828,734 (“the ‘734 patent”); 5,835,576 (“the ‘576 patent”); 5,898,762 (“the ‘762 patent”); 5,917,893 (“the ‘893 patent”); 5,974,120 (“the ‘120 patent”); 6,035,021 (“the ‘021 patent”); 6,148,065 (“the ‘065 patent”); 6,335,965 (“the ‘965 patent”); 6,349,134 (“the ‘134 patent”); 6,424,703 (“the ‘703 patent”); 6,434,223 (“the ‘223 patent”); 6,449,346 (“the ‘346 patent”); 6,512,415 (“the ‘415 patent”); and 6,678,360 (“the ‘360 patent”) (collectively, “the asserted patents”).

³ The nineteen patents asserted against the defendants in this case include the ‘968 patent, the ‘150 patent, the ‘984 patent, the ‘252 patent, the ‘285 patent, the ‘863 patent, the ‘551 patent, the ‘734 patent, the ‘762 patent, the ‘893 patent, the ‘120 patent, the ‘021 patent, the ‘065 patent, the ‘965 patent, the ‘134 patent, the ‘703 patent, the ‘223 patent, the ‘415 patent, and the ‘360 patent.

⁴ The ten patents currently involved in reexamination proceedings include United States Patent Nos.: 5,255,309, 5,259,023, 5,351,285, 5,561,707, 5,684,863, 5,787,156, 5,815,551, 5,828,734, 5,974,120, 6,292,547, and 6,434,223. In addition, a request for reexamination of United States Patent Nos. 5,128,984 has been submitted to the United States Patent and Trademark Office, but the PTO has not yet acted on the request.

additional patent that has also been asserted against TD BankNorth. In addition, since many of Plaintiff's patents are related to each other and also involve very similar technology, it is likely that others of Plaintiff's patents will be affected by the results of the currently pending reexamination proceedings.

For all the reasons cited in the Qwest Defendants' Motion to Stay and supporting memorandum and declaration (C.A. No 06-546, D.I. 80-82) and the motion filed earlier today by the Dillard's Defendants in this case (D.I. 64), which are incorporated herein by reference, TD BankNorth respectfully requests that the Court stay this action in its entirety pending the completion of all of the reexamination proceedings by the United States Patent and Trademark Office involving Plaintiff's United States patents that have been asserted in this action as well as other related but unasserted patents. Specifically, this Court should stay this action in its entirety because (1) Plaintiff will not be prejudiced, much less unduly prejudiced by such a stay; (2) such a stay will simplify the proceedings as a result of the findings of the reexamination proceedings, and thus conserve this Court's and the parties' resources relating to the investigation, discovery, analysis, and construction related to patent claims which are likely to be amended or even cancelled during reexamination; and (3) this action has not progressed past the initial pleading stage, discovery has not yet begun, and no trial date has been set.

For all of these reasons, TD BankNorth respectfully requests that the Court stay this action in its entirety pending the completion of all of the reexamination proceedings by the United States Patent and Trademark Office involving Plaintiff's United States patents that have been asserted in this action as well as other related but unasserted patents. A proposed form of order is attached hereto as Exhibit A.

Plaintiff's counsel has been contacted regarding this motion, and counsel has indicated that Plaintiff is opposed to the requested stay.

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Dated: December 19, 2006

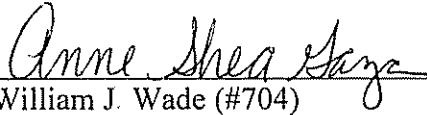

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EXHIBIT A

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

RONALD A. KATZ TECHNOLOGY)	
LICENSING, L.P.,)	
)	
Plaintiff,)	
)	
v.)	C.A. No 06-544 (GMS)
)	
TD BANKNORTH INC., et al.,)	
)	
Defendants.)	
)	

ORDER

On this ____ day of _____, 2007, came for consideration Defendant TD BankNorth's Motion to Stay Action Pending the United States Patent and Trademark Office's Reexamination of Plaintiff's Patents (the "Motion"). Having reviewed the parties' positions with respect to the Motion, the Court is of the opinion that the Motion should be granted and this case stayed at least until the United States Patent and Trademark Office's reexamination of patents assigned to Ronald A. Katz Technology Licensing L.P. is complete.

IT IS THEREFORE ORDERED this ____ day of _____, 2007 that Defendant TD BankNorth, Inc.'s Motion to Stay is GRANTED. Accordingly, all aspects of this case are stayed pending further order of this Court.

THE HONORABLE GREGORY M. SLEET
UNITED STATES DISTRICT JUDGE

UNITED STATES DISTRICT COURT
DISTRICT OF DELAWARE

CERTIFICATE OF SERVICE

I hereby certify that on December 19, 2006, I caused to be served by hand delivery the foregoing document and electronically filed the same with the Clerk of Court using CM/ECF which will send notification of such filing(s) to the following:

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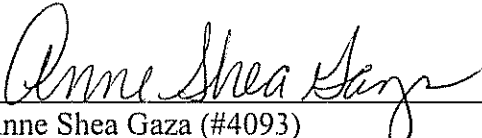
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